UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/662,599	09/15/2003	Bruce L. Kennedy	02580-P0085B	2356

24126 7590 08/20/2008

ST. ONGE STEWARD JOHNSTON & REENS, LLC
986 BEDFORD STREET
STAMFORD, CT 06905-5619

EXAMINER	
SMITH, PHILIP ROBERT	

ART UNIT	PAPER NUMBER
3739	

MAIL DATE	DELIVERY MODE
08/20/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/662,599
Filing Date: September 15, 2003
Appellant(s): KENNEDY, BRUCE L.

Wesley W. Whitmyer, Jr.
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 6/13/08 appealing from the Office action mailed 2/7/08.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

2003/0076410	BEUTTER	4-2003
6,411,851	WINKLER	6-2002

2003/0060678	WATAI	3-2003
2002/0149706	ROSEN	10-2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 19-31, 46-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beutter (2003/0076410) in view of Winkler (6,411,851).

With regard to claim 19: Beutter discloses a medical video instrument having touch screen control comprising: a touch screen ("[i]In response to touch-screen or voice generated commands...) for entering control commands ("the operating room control center 42 generates control signals to the camera control unit 34," [0030]) to control said medical video instrument ("endoscopic viewing system 20," [0026]), said medical video instrument inserted into a body cavity and generating an image stream representative of the body cavity and displayed on said touch screen; a processor ("operating room control center 42," as noted above) for receiving said control commands and for generating control signals to operate said medical video instrument; wherein the processor disclosed by Beutter is inherently enclosed by a housing.

Beutter does not disclose that said touch screen is movable between a first position at least partially within a footprint of said housing and a second position extended from said footprint of said housing.

Winkler discloses a processor ("programmer 200" comprising "computer circuitry") for receiving control commands (12/28-39) from a touch screen (comprising "display screen 206" & "stylus 208," column 12/ lines 6-10) and for generating control

signals to operate a medical instrument ("implantable medical device IMD 10"), analogous to the processor disclosed by Beutter. Winkler discloses that said touch screen is movable between a first position at least partially within a footprint ("folds down in a closed position") of said housing and a second position ("plurality of possible open positions") extended from said footprint of said housing (12/10-27).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art that the "operating room control center 42" having a "touch-screen" disclosed by Beutter take the particular form disclosed by Winkler. A skilled artisan would be motivated to do so in order to minimize space requirements when the control center is not in use; and to reduce potential for damage to the touch screen.

With regard to claims 20-21: the touch screen disclosed by Winkler is inherently unpluggable from said housing and includes stackable mating plug portions ("Display screen 206 is operatively coupled to computer circuitry disposed within housing 202" 12/23-24).

With regard to claim 22: the touch screen disclosed by Beutter in view of Winkler can inherently be used by a plurality of medical instruments. The medical instrument disclosed by Beutter ("endoscope 22") is interchangeable; the touch screen disclosed by Beutter is inherently capable of use with a replica of "endoscope 22" and is therefore "usable with" a plurality of medical instruments.

With regard to claims 23 & 30-31: As noted above, Winkler discloses that the touch screen slides out of the housing and is deflectable. Deflection, when it occurs, inherently occurs about some axis, which may be called the axis of said housing.

With regard to claims 24-25: As noted above, Winkler discloses a "stylus 208" with which to "interact with display screen 206" (13/8-9). It is clear from Fig. 6 that the touch screen slides up and out of the "closed position" into an "open position" where it is lodged in one of a plurality of slots in the housing and propped back at its sides against a rotating support. From this one of a plurality of open positions, the touch screen is clearly more difficult to deflect in the opening direction (propped back against the rotating support) than it is in the closing direction (laid flat within the housing), enabling the touch screen to interact with "stylus 208" without unintentional deflection.

With regard to claim 26: Touch screens conventionally present a keyboard to the user. Winkler suggests this when he states the following in 12/35-39: "Display screen 206 is the primary input medium for programmer 200, and therefore preferably has sufficient resolution to support operations including selection, gestures, annotation, and character recognition."

With regard to claim 27: Beutter further discloses a sensor ("camera head 28," [0027]) in communication with said processor, said sensor receiving control signals to operate said medical instrument.

With regard to claim 28: Beutter discloses a speech recognition module ("voice-generated commands," [0030]) executing on said processor, said speech recognition module receiving voice signals that control said medical instrument.

With regard to claim 29: Winkler further discloses an expert system executing on said processor ("analyzer 210"), said expert system generating control signals to operate said medical instrument (12/40-49).

With regard to claim 46: the medical video instrument disclosed by Winkler generates video data that is displayed on said touch screen.

With regard to claim 47: the video screen disclosed by Winkler is coupled to said processor, and said medical video instrument generates video data that is displayed on said video screen.

Claim 48 is rejected under 35 U.S.C. 103(a) as being unpatentable over Beutter (2003/0076410) in view of Winkler (6,411,851) and in further view of Watai (2003/0060678). Beutter in view of Winkler does not disclose a storage for storing the image stream. Watai discloses a "hard disk 21e for storing image data" ([0064]). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to store the image data disclosed by Beutter in view of Winkler as taught by Watai. A skilled artisan would be motivated to do so in order to preserve captured medical data.

Claims 19, 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beutter (2003/0076410) in view of Rosen (2002/0149706). With regard to claim 19: Beutter discloses a medical video instrument having touch screen control comprising: a touch screen ("[i]In response to touch-screen or voice generated commands...) for entering control commands ("the operating room control center 42 generates control signals to the camera control unit 34," [0030]) to control said medical video instrument ("endoscopic viewing system 20," [0026]), said medical video instrument inserted into a body cavity and generating an image stream representative of the body cavity and displayed on said touch screen; a processor ("operating room control center 42," as noted above) for receiving said control commands and for generating control signals to

operate said medical video instrument; the processor disclosed by Beutter is inherently enclosed by a housing.

Beutter does not disclose that said touch screen movable between a first position at least partially within a footprint of said housing and a second position extended from said footprint of said housing. Rosen discloses that a touch screen ("20") is movable between a first position at least partially within a footprint ("slot 18") of a housing and a second position (see Figures 5-6) extended from said footprint ("free space adjacent to free edge 16") of said housing. See [0025]-[0028].

At the time of the invention, it would have been obvious to a person of ordinary skill in the art that to combine the medical video instrument disclosed by Beutter with the retractable monitor disclosed by Rosen. It is obvious to combine prior art elements according to known methods to yield predictable results. In combination, the medical video instrument and the retractable monitor would have performed the same function as they had separately; a skilled artisan would have recognized that the result of the combination was predictable.

With regard to claim 49: As noted above, Rosen discloses that said touch screen is in the first position, said touch screen is positioned within an interior cavity of said housing and when said touch screen is moved to the second position, the touch screen positioned at least partially outside of said cavity.

(10) Response to Argument

Applicant contends on page 5 that the a skilled artisan would not apply the advantages of Winkler's touch screen housing to the touch screen disclosed by Beutter:

"while applicable for the portable device taught in Winkler, [the given motivations] simply don't apply to the operating room system taught in Beutter. For example, the rough handling a portable device may be subjected to when transported from one location to another is not an issue for an operating room system that is non-portable but is provided to be permanently maintained in an operating room. Likewise, the space constraints and difficultly in handling multiple pieces of equipment to be carried from location to location is simply not an issue for a static operating room system that once installed, is not thereafter moved."

Firstly, Applicant presumes that Beutter discloses an endoscopic viewing system which is intended exclusively for "a static operating room system". There is no support for such an assertion. Secondly, even if such an assertion were accepted as accurate, it is judged that utilizing an instrument strictly within the confines of an operating room does not obviate the need to protect a delicate touch screen while not in use, or to minimize the space requirements. The arrangement of Winkler provides for both: when the operating room is not being used for operating, the touch screen disclosed by Beutter may be protected in accordance with the arrangement disclosed by Winkler. When patients are being moved in or out of the operating room, or the operating room is being cleaned or prepared, the touch screen has a reduced profile and a limited exposure to unintended contact.

Applicant reiterates on page 5 that Winkler discloses a "portable device" and that Beutter discloses a "non-portable system". Again, there is no basis for this conclusion. Furthermore, Applicant contends that "[t]o modify Beutter to position the monitor in a

flip-up case containing the CCU 34 would limit the ability of the physician to position the monitor, for example, in a convenient location over the patient during a procedure for optimum viewing by the physician". However, the modification made in the outstanding rejection did not involve the "CCU 34" but simply the "monitor 36". It is maintained that it would have been obvious at the time of the invention to allow the modification to make Beutter's touch screen movable between first and second positions within a housing, as disclosed by Winkler.

Applicant contends on page 6 that "when the instrument is rack-mounted, there is no ability to tilt the device upward as taught in Winkler because there is equipment mounted above (and below) the device in a rack mounted arrangement. Rather, in a rack mounted system including "stackable mating plug portions" as per claim 21, the screen would need to extend from the device as illustrated in Figures 5a-5c". It is not clear that the recited "stackable mating plug portions" require the elaborate rack-mounted arrangement of screen and housing identified in the arguments of page 6. Claim 21 does not recite a "rack", nor does it refer to the arrangement of the touch screen relative to the housing. As noted above, the touch screen disclosed by Winkler is "operatively coupled to computer circuitry disposed within housing 202". Such an arrangement conventionally requires "mating plug portions" which are always used to operatively connect various electronic elements. The modifier "stackable", besides being broad, does not require that the mating plug portions be "stacked", but only that they be "stackable". It is maintained that mating plug portions are inherently "stackable" according to the meaning in plain English, and that the portions of the specification

pointed to by the Applicant do not further animate the phrase. The so-called "vertically stacked IDE bus 116" appears to have little relevance to the recited "stackable mating plug portions"; element "116" is certainly not "included" in the "touch screen", and therefore can not be basis for the recited "stackable mating plug portions".

Applicant contends on page 7 that "Winkler is limited to disclosing that the touch screen folds downward and lies flat alone the outer surface of the housing. There is no interior cavity of said housing within which the touch screen is positioned." It is maintained that Winkler discloses the recited "first position" of claim 49, where the touch screen is positioned "within an interior cavity". It is maintained that in a stored position, the touch screen disclosed by Winkler "folds down in a closed position when programming apparatus 200 is not in use... protecting the display surface of display screen 206 during transportation and storage", and that such a position is a recited first position, in which the touch screen is positioned "within an interior cavity". If the touch screen were not positioned within an interior cavity, as Applicant contends, it is difficult to comprehend how it would be "protect[ed]... during transportation and storage".

Applicant further contends that "Winkler teaches away from this limitation stating that "[d]isplay unit 206 is disposed on the upper surface of housing 202."" Clearly, this refers to the open, or second position, and has no bearing on the closed, or first position. Teaching that a touch screen is capable of two positions, and that the second position is different from the first, is clearly not "teaching away" from the first position.

On page 8, Applicant again refers to "the rack mounted system configuration". No such configuration is recited in the claims. The touch screen of Winkler, which is

"operatively connected" to the housing, is inherently "unpluggable", in that it is capable of being unplugged.

On page 9, Applicant contends that no evidence is provided for the assertion that the touch screen disclosed by Beutter in view of Winkler can inherently be used by a plurality of medical instruments. It is maintained that the "endoscope 22" may be exchanged for, e.g., a replacement "endoscope 22". Such a replacement "endoscope 22" need not be explicitly disclosed; any element composing a system of multiple elements may presumably be replaced as needed. The claim broadly recites that "said touch screen can be used by a plurality of medical instruments". The touch screen disclosed by Beutter in view of Winkler may inherently be "used by a plurality of medical instruments" just as a light bulb may be used by a plurality of lamps. Exchangeable components are an inherent property of composite systems.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

(12) Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PHILIP R. SMITH whose telephone number is (571)272-6087. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272 4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Philip R Smith/
Examiner, Art Unit 3739

Conferees:
/Angela D Sykes/
Supervisory Patent Examiner, Art Unit 3762

/Linda C.M. Dvorak/
Supervisory Patent Examiner, Art Unit 3739